

REMARKS

The Office Action mailed October 7, 2008, has been carefully considered.

Reconsideration in view of the following remarks is respectfully requested.

Claim Status and Amendments to the Claims

Claims 1-62 are currently pending.

No claims stand allowed.

Claims 1, 3, 9-12, 18-21, 27, 29, 31, 33, 35, 41-44, 51-54, and 60-62 have been amended to further particularly point out and distinctly claim subject matter regarded as the invention. Support for these changes is found in the specification, figures, and claims as originally filed. The amendment also contains minor changes of a clerical nature. No “new matter” has been added by the amendment.

The 35 U.S.C. § 102 Rejection

Claims 1-2, 5, 8-11, 14, 17-20, 23, 26-34, 37, 39-43, 46, 49-53, 56, and 59-62 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Rigaldies et al.^{1,2} This rejection is respectfully traversed.

According to the M.P.E.P., a claim is anticipated under 35 U.S.C. § 102(a), (b) and (c) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.³

¹ U.S. Patent No. 6,792,085 to Rigaldies et al.

² Office Action mailed January 22, 2008, at ¶ 6.

³ Manual of Patent Examining Procedure (MPEP) § 2131. See also *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 1

Claim 1 as presently amended recites:

A method comprising:

receiving, at a mail server, information from a first user computing device regarding every change made to an application database located on the first user computing device;
 storing the information in a mail folder on the mail server, the mail folder corresponding to a user associated with the first user computing device and a second user computing device; and
 forwarding the information from the mail folder to the second user computing device upon receipt of a synchronization request from the second user computing device, the second user computing device maintaining a copy of the application database.

The Examiner states,

...Rigaldies discloses a method, comprising:
 receiving, at a mail server, information from a first device regarding every change made to an application database located on the first device (Abstract; Col. 4, In. 29-35 and 4160; Col. 22, In. 21-23; the client, e-mail server and voice-mail all have respective databases in the form of workstation mailbox, e-mail message store, and voice-mail message store respectively; Fig. 6; Col. 13, In. 43-60; Col. 15, In. 44-58; Col. 19, In. 40-57; on-going synchronization occurs via the agent notifying the voice-mail server of any new status of a message);
 storing the information in a mail folder on the mail server, the mail folder corresponding to a user associated with the first device and a second device (Abstract; Fig. 14; Col. 10, in. 1-8; Col. 15, In. 59 - Col. 16, In. 6; the workstation mailbox is replicated/synchronized to the voice-mail server, the voice-mail server inherently includes a mailbox representing the user to accomplish said replication/synchronization); and
 forwarding the information from the mail folder to the second device upon receipt of a synchronization request from the second device (Fig. 2; Col. 12, In. 14-43).⁴

In support of the Examiner's statement, the Examiner refers to portions of Rigaldies et al. that disclose a form of direct connection synchronization discussed in the Background section of the present application, where an agent 110 on a workstation 101 updates a voicemail server 200, and further the voicemail server 200 updates the agent 110 on the workstation. This aspect of Rigaldies et al. is summarized as follows:

⁴ Office Action dated October 7, 2008, ¶ 8.

The synchronization perform by the unified messaging system of the invention may be characterized as “two-way synchronization” because it is really a bilateral process performed between the *two* respective data stores of the voice-mail system and the e-mail system. Either end has to tell the other end what the other has done, hence *two* way.⁵

Embodiments of the invention as presently claimed feature a mail server that is a *third* device which is separate from both a first user computing device and a second user computing device, where the mail server (1) receives information from the first user computing device regarding every change made to the application database on the first user computing device, (2) stores the information in a mail folder corresponding to a user associated with the first user computing device and a second user computing device on the mail server, and (3) forwards the information from the mail folder to the second user computing device upon receipt of a synchronization request from the second user computing device. This is not disclosed by the cited art of record. With this Amendment, Claim 1 has been amended to make this distinction more clear. Specifically, Claim 1 has been amended to refer to a first user computing device in lieu of a first device, and to refer to a second user computing device in lieu of a second device. Support for this Amendment is found in the Specification, Figures, and claims as originally filed. For example, support is found in the Specification at paragraph 25, last sentence, and paragraph 27.

The Examiner’s rejection equates the voice-mail server 200 of Rigaldies et al. with the mail server of Claim 1. The Examiner also equates the e-mail server 300 in Rigaldies et al. with the first device of Claim 1. The Examiner also equates the workstation 101 in Rigaldies et al. with the second device of Claim 1. In support of the Examiner’s contention that Rigaldies et al. discloses “receiving, at a mail server, information from a first device regarding every change

⁵ Rigaldies et al. at col. 5 11, 7-12. (emphasis added)

made to an application database located on the first device,” the Examiner refers to portions of Rigaldies et al. that speak generally about the voice-mail server 200 receiving information from workstation 101. Whereas the Examiner’s mapping would require the voice-mail server 200 receiving information from e-mail server 300 regarding every change made to an application database located on the e-mail server 300.

Furthermore, contrary to the Examiner’s statement at paragraph 3 of the Office Action, the Applicant did not assert that Rigaldies et al. does not disclose “an information flow from the e-mail server to the voice-mail server.” Rather, the Applicant has asserted and continues to assert that the portion of Rigaldies et al. on which the Examiner relies to support a rejection under 35 U.S.C. §102 does not disclose the limitations found in Claim 1. In particular, using the mapping provided by the Examiner, Rigaldies et al. does not disclose receiving, at a mail server, information from a first device regarding every change made to an application database located on the first device as required by Claim 1.

As the limitations of Claim 1 are not found in cited art of record, the rejection must be withdrawn.

Independent Claims 9, 18, 27, 29, 31, and 60-62

Claims 9, 18, 27, 29, 31 , and 60-62 include limitations similar to those discussed above with respect to Claim 1. Claim 1 being allowable, Claims 9, 18, 27, 29, 31 , and 60-62 must also be allowable.

Dependent Claims 2, 5, 8, 10-11, 14, 17, 19-20, 23, 26, 28, 30, and 32

Claims 2, 5, and 8 depend from Claim 1, Claims 10-11, 14, and 17 depend from Claim 9. Claims 19-20, 23, and 26 depend from Claim 18. Claim 28 depends from Claim 27. Claim 30

depends from Claim 29. Claim 32 depends from Claim 31. Claims 1, 9, 18, 27, 29, and 31 being allowable, Claims 2, 5, 8, 10-11, 14, 17, 19-20, 23, 26, 28, 30, 32 must also be allowable.

The First 35 U.S.C. § 103 Rejection

Claims 3, 12, 21, 35, 44, and 54 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over claims 2, 9, 18, 34, 41 and 51 above, in view of Christie et al.,⁶ among which no claims are independent claims.⁷ This rejection is respectfully traversed.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.⁸

The 35 U.S.C. § 102 rejection of independent Claims 1, 9, 18, 27, 29, 31, and 60-62 as presently amended based on Rigaldies et al. is unsupported by the art, as each and every element as set forth in the claim is not found, either expressly or inherently described, in Rigaldies et al. Accordingly, the 35 U.S.C. § 103(a) of dependent claims 3, 12, 21, 35, 44, and 54 based on Rigaldies et al. and further in view of Christie et al. is unsupported by the art because the combination of Rigaldies et al. and Christie et al. does not teach all claim limitations.

The Second 35 U.S.C. § 103 Rejection

Claims 4, 6, 13, 15, 22, 24, 36, 38, 45, 47, 55, and 57 stand rejected under 35 U.S.C. §

⁶ U.S. Patent No. 5,757,669 to Christie et al.

⁷ Office Action at ¶ 21.

⁸ M.P.E.P. § 2143.

103(a) as allegedly being unpatentable over Rigaldies et al. as applied to claims 2, 9, 18, 34, 41 and 51 above, in view of LaRue et al.^{9 10} This rejection is respectfully traversed.

The 35 U.S.C. § 102 rejection of independent Claims 1, 9, and 18 as presently amended based on Rigaldies et al. is unsupported by the art, as each and every element as set forth in the claim is not found, either expressly or inherently described, in Rigaldies et al. Accordingly, the 35 U.S.C. § 103(a) of dependent claims 4, 6, 13, 15, 22, and 24 based on Rigaldies et al. and further in view of LaRue et al. is unsupported by the art because the combination of Rigaldies et al. and LaRue et al. does not teach all claim limitations.

The Third 35 U.S.C. § 103 Rejection

Claims 7, 16, 25, 48, and 58 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Rigaldies et al. as applied to claims 2, 9, 18, 34, 41, and 51 above, in view of Malik.^{11 12} This rejection is respectfully traversed.

The 35 U.S.C. § 102 rejection of independent Claims 1, 9, and 18 as presently amended based on Rigaldies et al. is unsupported by the art, as each and every element as set forth in the claim is not found, either expressly or inherently described, in Rigaldies et al. Accordingly, the 35 U.S.C. § 103(a) of dependent claims 7, 16, and 25 based on Rigaldies et al. and further in view of Malik is unsupported by the art because the combination of Rigaldies et al. and Malik does not teach all claim limitations.

Claims 33-59

Claims 33-59 are means-plus-function claims. In support of the 35 U.S.C. § 102

⁹ U.S. Patent No. 6,449,622 to LaRue et al.

¹⁰ Office Action at ¶ 24.

¹¹ U.S. Publication No. 2002/0065 892 to Malik.

¹² Office Action at ¶ 27.

rejection of Claims 32-34, 37, 39-43, 46, 49-53, 56, and 59, and in the support of the 35 U.S.C. § 103 rejections of Claims 35-36, 38, 44-45, 47-48, 54-55, and 57-58, the Examiner refers to substantially the same portions of the cited references used in the Examiner's rejection of method claims, *In re Beauregard* claims, and non-means-plus-function apparatus claims. The Examiner is referred to the U.S. Patent and Trademark Office document entitled "Examination Guidelines For Claims Reciting A "Means or Step Plus Function" Limitation In Accordance With 35 U.S.C § 112, 6th Paragraph" ("Guidelines"), a copy of which is submitted herewith for the Examiner's convenience. The Guidelines state:

... Per our holding, the 'broadest reasonable interpretation' that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, *the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a Patentability determination ...*

... [The] examiner shall interpret a § 112, 6th paragraph "means or step plus function" limitation in a claim as limited to the corresponding structure, materials or acts described in the specification and equivalents thereof in acts accordance with the following guidelines.¹³

The Guidelines state further:

... if a prior art reference teaches identity of function to that specified in a claim, then under Donaldson an examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function.¹⁴

As Claims 33-59 of the present application are means-plus-function claims they cannot be said to be drawn to identical subject matter as the method claims, the *In re Beauregard* claims, and the non-means-plus-function apparatus claims. Furthermore, the Examiner has not shown for each means-plus-function claim, that the prior art structure or step is the same as or equivalent to the

¹³ "Examination Guidelines For Claims Reciting A "Means or Step Plus Function" Limitation In Accordance With 35 U.S.C § 112, 6th Paragraph," U.S. Patent and Trademark Office, <http://www.uspto.gov/web/offices/pac/dapp/pdf/exmgui.pdf>, p. 1. (emphasis added)

¹⁴ Guidelines at p. 3. (emphasis in original)

structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function.

In the Office Action mailed January 22, 2008, The Examiner stated:

Applicant argued that the examiner did not properly treat the means-plus-functions claims 33-59. However, Applicant is directed to Applicant's own specification (Fig. 7-9; corresponding paragraphs [003 1] - [0033]). The means are broadly defined via such terms as "first device database change information receiver" and "first device database change information mail folder storer." Clearly, if the method claim was rejected for steps such as receiving, at the mail server, information from a first device regarding every change made to the application database and storing said information in a mail folder on said mail server (see the rejection of claim 1), then means for accomplishing such steps must be present in the system of Rigaldies.¹⁵

In the Response filed June 23, 2008, the Applicant argued that in stating "[c]learly, if the method claim was rejected for steps such as receiving, at the mail server, information from a first device regarding every change made to the application database and storing said information in a mail folder on said mail server (see the rejection of claim 1), then means for accomplishing such steps must be present in the system of Rigaldies," the Examiner appears to be stating that a proper rejection of a means-plus-function apparatus claim requires merely showing that *any* means for accomplishing the steps in a corresponding non-step-plus-function method claim are found in the reference used to reject the non-step-plus-function method claim. The Applicant respectfully submits this does not comport with current Patent Office Guidelines regarding the examination of means-plus-function claims. Again, Examiner has not shown for each means-plus-function claim, that the prior art structure in Rigaldies et al. is the same as or equivalent to the structure described in the specification which has been identified as corresponding to the claimed means plus function. Therefore, the Examiner has not established a *prima facie* case. And considering that the Examiner has not provided any comments or rebuttal to the Applicant's argument, but

¹⁵ Office Action mailed January 22, 2008, at ¶ 5.

only restated prior rejections, it can be assumed that the Examiner agrees to the Applicant's arguments and that the Claims are allowable.¹⁶ Accordingly, both the 35 U.S.C. § 102 rejection of Claims 32-34, 37, 39-43, 46, 49-53, 56, and 59, and the 35 U.S.C. § 103 rejections of Claims 35-36, 38, 44-45, 47-48, 54-55, and 57-58 must be withdrawn.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

Conclusion

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

The Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-3557.

Respectfully submitted,
NIXON PEABODY LLP

Dated: March 6, 2009

/ John P. Schaub/
John P. Schaub
Reg. No. 42,125

NIXON PEABODY LLP
200 Page Mill Road
2nd Floor
Palo Alto, CA
94306-2022
Tel. (650) 320-7700
Fax. (650) 320-7701

¹⁶ *In re Herrmann*, 261 F.2d 598 (CCPA 1958) (The court noted that since applicant's arguments were not questioned by the examiner, the court was constrained to accept the arguments at face value and thus held the claims to be allowable); *See In re Soti*, 54 F.3d 746 (Fed. Cir. 1995).